

REMARKS

INTRODUCTION

Per telephone communications with the supervisory Examiner, Eric Stamber,¹ the aforementioned new Final Office Action sets a new statutory time period for response and replaces the earlier Final Office Action and Advisory Action. The submission herein is filed, in conjunction with the Request for Continued Examination (RCE) of the above-references application, under 37 C.F.R. §1.114 and §1.116 in response to the new Final Office Action.

In proposing the claim amendments herein, Applicants assume that the earlier Response filed on December 22, 2003 was not entered and is, therefore, ignored as moot in view of the present response. That is, the claims have been amended herein vis-à-vis the claims as existed prior to September 16, 2003, rather than vis-à-vis the claims in the Response of December 22, 2003.

RESTRICTION REQUIREMENT AND ELECTION:

In this Office action, the Examiner has imposed a restriction requirement dividing the claims into two groups, one group consisting of claims 1-8, 24-26 and 38-59, and the second group consisting of claims 27-37 and 60-70. The Examiner considered the claims of the first group, claims 1-8, 24-26 and 38-59.

In the previous Office Action dated May 13, 2003, the Examiner has also issued a restriction requirement, dividing the claims into two groups consisting of claims 1-8 and claims 9-23 respectively. In response to that Office Action, Applicants argued that this restriction requirement was not supported by the claimed invention as recited in claims 1-23.

Applicants still believe that, although an election of claims 1-8 was apparently done without traverse by prior counsel, a clarification of the claims would have all together obviated these restriction requirements and elections.² Notwithstanding, to allow Examination of this application to move forward Applicants have cancelled claims 27-37 and 60-70 without prejudice or surrender of any subject matter and reserve the right to present the unelected claims in a continuation/divisional application.

¹Confirmation received in a voice -message from Eric Stamber, date-stamped February 23, 2004, and Interview Summary dated March 8, 2004.

²Applicants' arguments to that effect as provided in Applicants' response dated August 25, 2003, are incorporated herein by reference.

STATUS OF THE CLAIMS

Applicants amended claim 46 to correct a typographical error, as pointed out by the Examiner. In addition, Applicants amended claims 1-5, 25, 26, 38-48, and 50-57 to recite the invention more clearly. Claim 71 has been added to further point out various aspects of the invention. Accordingly, claims 1-8, 24-26, 38-59, and 71 are now pending examination.

CLAIM REJECTIONS UNDER 35 USC §102

In this Office Action claims 38-40, 43, 44, 46 and 48, have been rejected under 35 USC §102 as being anticipated by U.S. Patent 6,061,660 Eggleston. However, Eggleston does not support this claim rejection, as will be explained below. In particular, Eggleston does not anticipate nor does it enable claims 38-40, 43, 44 and 46.

As to claim 38, for example, Eggleston disclose none of the “auction web server,” “store web server,” or “web server” from which the auction web server and store web server are “accessible to a user for interacting therewith, including for participating in the auction of an item..., the web server, in turn, being accessible to the user from either or both of the auction web server and the store web server.” Rather, Eggleston discloses a host computer (18) and one or more consumer and sponsor sites, where a “client” encompasses any system for establishing communication to an Internet site, and a “host” system permits sponsoring companies to offer incentive programs to consumers and, to that end, it stores files for implementing a consumer site, a sponsor site and an award site (Eggleston, col. 7, 18-25, and col. 8, lines 13-20). A consumer operating a browser locates a consumer site for registration to become a member of the host incentive program system, where the consumer site has hyperlinks to other sites, e.g., incentive programs from the directory of programs provided by the host or third parties (Eggleston, col. 12, lines 12-37). In other words, to get to a one of the different sites, a client visits a consumer site and from there it uses a link to the next site. Eggleston also does not specifically disclose points being characterized as “purchase” points and being “redeemable for value including the winning bid price of the item being auctioned.” (Eggleston, e.g., col. 12, line 58 to col. 13, line 27, col. 13, lines 43-58, col. 26, lines 62-66 col. 35, lines 21-37, col. 36, lines 20-39). Finally, because Eggleston does not teach or suggest, explicitly or implicitly, all the elements of the system as recited in claim 38 it does not enable producing such system. Thus, Eggleston does not anticipate claim 38.

Likewise, Eggleston does not teach or suggest all the limitations of the on-line off-line incentive points system as recited in claim 43. Among others, Eggleston does not disclose “an

account database configured with accounts for users, each user account contains points earned by that user, wherein the points are redeemable for value, including...an auctioned item for which the user submitted a winning bid..." Instead, Eggleston discloses a host site with hyperlinks to one or more other sites, consumer registration records (name, ID, password, account number), sub-records (historical participation in incentive programs), winning sub-records, award or points sub-records, demographics sub-records, and consumer and sponsor databases (Eggleston, e.g., col. 12, lines 12-37, and col.13, lines 1-60). A winning sub-record records winning activities by the consumer and the award sub-record records loyalty points or prizes won by the consumer. *Id.* In Eggleston, win-eligible activities include completing a survey or participation in a scratch game, sweepstakes, or other game. *Id.* It is not surprising why Eggleston does not teach or suggest points redeemable for auctioned items; Eggleston is directed to implementing and using incentive programs but not auctions. In view of its failure to teach or suggest, all the elements of the system of claim 43 and its further failure to enable such system, Eggleston does not anticipate claim 43.

The dependent claims are themselves patentably distinguishable from Eggleston. For example, as to claim 44, Eggleston maintains program codes for creating incentive programs (based on parameters specified by the sponsors), which is entirely different from "code server including a code database...for maintaining valid codes against which a code submitted by a user is verifiable" (Eggleston, e.g., col. 29, line 51 to col. 30, line 65).

In other words, Eggleston does not anticipate claims 38, 38 and 43 and, likewise, it does not anticipate dependent claims 39, 40, 44-46.

CLAIM REJECTIONS UNDER 35 USC §103

Further in this Office Action, claims 1-8, 24-26 and 50-59 have been rejected under 35 USC §103 as being unpatentable over U.S. Patent 5,996,997 to Kamille in view of Eggleston. Kamille, however, does not support this claim rejection, either singly or in combination with Eggleston and alleged knowledge in the art, as will be explained below.

As indicated once before and as acknowledged by the Examiner in this office action,³ Kamille does not teach or suggests all the limitations of claims 1-8, 24-26 and 50-59, and Eggleston does not make up for Kamille's deficiency. Firstly, the proposed combination of Kamill and

³Office Action, pages 2, section 1, and pages 5 et seq.

Eggleston is improper,⁴ and, secondly, Eggleston does not teach the elements missing from Kamille even if the proposed combination would have been proper.

For example, claim 1 recites an offline-online points system that includes

main server configured for providing a user with an interface to submit a code obtainable by the user from an item; and

code server configured for maintaining a set of codes deemed to be valid and for comparing the code submitted by the user against the set of valid codes, wherein if based on the comparison the code is deemed valid the user is credited with a given number of points, wherein points earned by or credited to the user are accumulated, the accumulated points being redeemable for value, including one or more of a prize, a gift, a purchase price discount, a purchased item, and an auctioned item for which the user submitted a winning bid.

Kamille, on the other hand, does not teach or suggests terms such as “server”, “interface”, “points”, “account”, or “balance”. Indeed, Kamille, unlike the offline-online points system of claim 1, discloses a probability game system for redeeming a validated game piece on which there is winning a value indication (see, e.g. Figures 1-4C, abstract, and col. 12, lines 15-41). Kamille does not accumulate points in return for a valid code submission nor does it maintain an account of redeemable points. Rather, in Kamille, once the winning value is exposed on the game piece and is redeemed, assuming the game piece has been validated, the game piece is no longer valuable and no additional record is kept. Eggleston also does not teach or suggest accumulation of points once the code is validated (nothing in col. 35, lines 21-49, suggests validation of code and accumulation of points once the code is validated). In the present invention, the points are accumulated once the code is validated and redeemable at some point in the future. Moreover, nothing in Eggleston suggests redeeming points for value, including an auctioned item for which a winning bid is submitted.

Consistent with the accumulation of points in a user account, as recited in claims depending from claim 1, e.g., claims 2-4, the offline-online points system of claim 1, further includes a user database. The database is configured for holding the account for the user, wherein the balance of the account is M points prior to the user’s submission of the code and is M+N points once the code is validated. By contrast, Kamille does not disclose an account database, and it does not disclose the addition of N points to the balance, M, of a user account once the code is validated, so that the

⁴Kamille U.S. Class 273/139; Eggleston U.S. Class 705/14. On one hand, Kamille is directed to a probability game system for redeeming a validated game piece on which there is winning a value indication (see, e.g. Figures 1-4C, abstract, and col. 12, lines 15-41). Once Kamille’s winning value is exposed on the game piece and the winning value is redeemed, assuming the game piece has been validated, the game piece is no longer valuable. On the other hand, Eggleston is directed to implementing (creating and instantiating) incentive programs purchased by

balance increases to M+N points.⁵ Indeed, Kamille does not even mention the terms “account” or “balance” and such terms cannot be attributed to Kamille; Eggleston does not mention this either.

For these and other reasons, Kamille does not teach or suggest the claimed invention as recited in claims 1-8 and 24-26, either singly or in combination with Eggleston. Additionally, Applicants respectfully object to the Examiner’s allegation that encryption was known in the art and thus it was obvious to combine this knowledge with the teachings of the cited references to produce the claimed invention as recited in claims 24 (and 51). Mere knowledge of the existence of encryption is not enough. There is no support anywhere in the references for employing encryption in the context of an offline-online incentive pints system for preventing unauthorized access to the points as recited and described in the present application, and no other support for such allegation has been provided by the Examiner. In other words, a proposed combination of knowledge in the art about encryption with the teachings of the cited references in order to produce the claimed invention cannot avoid impermissible use of hindsight gleaned from the present invention. A similar objection is made as to the Examiner’s allegation that incentive playing pieces are well known (e.g., bottle cap) and render claims 26 (and 59) obvious for this reason.

As to the method claims, Kamille and Eggleston, singly or in combination, fail to teach or suggest the method of claim 50 and, in particular:

- obtaining a code offline from an item;
- submitting the code online to a server that maintains a set of codes deemed valid; and
- at the server, comparing the code against the set of valid codes and, if the code is found to be valid, crediting a user that submitted the code with a given number of points wherein points earned by or credited to the user are accumulated, the points being redeemable for value, including an auctioned item for which the user submitted a winning bid in an auction.

Stated another way, the combined teachings of Kamille and Eggleston, fail to teach or suggest: “server that maintains a set of codes deemed valid,” and “at the server, comparing the code against the set of valid codes and, if the code is found to be valid, crediting a user that submitted the code with a given number of points wherein points earned by or credited to the user are accumulated, the points being redeemable for value, including an auctioned item for which the user submitted a winning bid in an auction.”

sponsors, instantiating consumer and sponsor web sites and accessing these website to interact with same for registration and obtaining awards.

⁵Kamille, e.g., col. 3, lines 18-35, col. 5, lines 30-47, and col. 12, lines 15-41

The claims that depend from claim 50 are themselves patentably distinguishable from the cited art. In view of the foregoing, claims 1 and 50 and their respective dependent claims 2-8, 24-26 and 51-59 are not rendered obvious by the cited references, singly, combined, or in further combination with any alleged knowledge in the art. Moreover, by analogy, new claim 71 is not rendered obvious by these references.

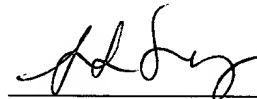
CONCLUSION

For these reasons, claims 1-8, 24-26, 38-59, and 71 are allowable over the cited reference and alleged knowledge in the art. Thus, as the application is believed to be ready for allowance, a Notice of Allowance of these claims is hereby respectfully requested.

Authorization is hereby given to charge any fee deficiency or credit any overpayment to Deposit Account 50-2778. Should any matter remain unresolved or if any question remains unanswered the Examiner is kindly invited to contact the undersigned Applicant's attorney at (650) 813-4873.

Date: March 16, 2004

Respectfully submitted



Leah Sherry
Reg. No. 43,918

DECHERT LLP

Customer No. 37509

Telephone: 650.813.4800

Facsimile: 650.813.4848

CERTIFICATE OF MAILING (37 CFR 1.10(a))

CERTIFICATE OF MAILING BY "EXPRESS MAIL" - Rule 10: I hereby certify that this correspondence is being deposited on March 16, 2004 with the U.S. Postal Service "Express Mail Post Office to Addressee" under 37 CFR 1.10 as **EL 989 608 029 US** addressed to: Mail Stop RCE, Commissioner for Patents, P.O. Box 1450, Alexandria, VA, 22313-1450

Date: March 16, 2004



Yvette Yturra de-Owen